

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and amended as necessary to more clearly and particularly describe the subject matter which Applicant regards as the invention.

Claims 5-7, and 13-18 remain in this case. Claims 1-4 and 8-12 have been cancelled. Claims 13 and 18 have been amended for editorial reasons, only. Claims 18-19 have been indicated as being allowable. Claims 14-16 are objected to as being allowable if put into independent format.

The Examiner rejected claims 5-7, 13, and 17 under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto *et al.* (U.S. 6,218,650) in view of Ueda *et al.* (U.S. 6,040,564) or Takahashi *et al.* (U.S. 6,008,482). For the following reasons, the rejection is traversed.

Claim 13 recites "a control part having an evaporator dish cleaning mode to clean soil on the evaporator dish by pumping a cleaning liquid into the evaporator dish and heating it with the evaporating dish heating unit for a predetermined period of time". Tsukamoto does not teach any such control part.

The Examiner fails to cite any component as teaching the control part of the claim. Instead, the examiner merely states that the reference teaches a "control part (typical)...." Applicant assumes that the Examiner means to argue that a control part, as recited in claim 13, is inherent to the Tsukamoto design.

However, it is not enough to merely allege that a function or feature is "inherent". The Examiner must provide *evidence* and/or a *rationale* to show inherency. See MPEP §2112. The fact that a certain result or characteristic *may* occur or be present in the prior art is *not* sufficient to establish the inherency of that result or characteristic. See *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was *necessarily present* in the

prior art) (emphasis added); see also *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so *recognized* by persons of ordinary skill. Inherency, however, may *not* be established by *probabilities* or *possibilities*. The mere fact that a certain thing *may* result from a given set of circumstances is *not* sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical *reasoning* to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Examiner has provided no showing (providing no rationale and/or evidence) that the control part of claim 13 is *necessary* to the proper functioning of the Tsukamoto device. In fact, no such showing can be made, because the Tsukamoto cleaning feature could just as well be manually operated.

Furthermore, claim 13 clearly recites that the control part is for "pumping a cleaning liquid into the evaporator dish" and for "heating [the cleaning fluid] with the evaporating dish heating unit for a predetermined period of time". Thus, two functions of the control part are clearly recited. Thus, the Examiner needs to show not only that the reference teaches a control part, but he must also show a teaching that any control part of the reference, inherent or not, performs these specific functions, which clearly do not "necessarily flow" from any teaching of the reference.

Accordingly, the Examiner has neither shown any explicit teaching of the "control part" of claim 13, nor shown that such a part is inherently taught by the Tsukamoto reference. One skilled in the art of the invention and/or reference would not find such a control part "inherent", and clearly would not find the specific functions of the control part specified in the claims

inherent. Thus, the Tsukamoto reference does not teach, explicitly or inherently, the control part as specified by claim 13. The remaining references fail to overcome the Tsukamoto shortcomings. Accordingly, claim 13 is patentable over the references, as are the remaining rejected claims which depend, directly or indirectly, upon claim 13.

Furthermore, the Examiner has failed to provide a prima facie case of obviousness, because the Examiner's cited motivation is not legally sufficient. Thus, the rejections should be withdrawn.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 35996.

Respectfully submitted,

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